

Election #6
7.9.02

PATENT
Customer No. 22,852
Attorney Docket No. 06478.1455-00



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Juergen ROEMISCH et al.

Application No.: 09/849,343

Filed: May 7, 2001

For: STABILIZED PROTEIN
PREPARATION AND PROCESS
FOR ITS PREPARATION

)
)
) Group Art Unit: 1644

) Examiner: Phuong (Neon) Huynh, Ph.D.
)
)

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Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Restriction Requirement

In the Office Action dated May 7, 2002, the Office required restriction under 35 U.S.C. § 121 between Group I (Claims 1-9 and 14-16) and Group II (Claims 10-13). Applicants provisionally elect, with traverse, to prosecute Group I (Claims 1-9 and 14-16).

Section 803 of the M.P.E.P. states that "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

(M.P.E.P. § 803, emphasis added.) Applicants respectfully submit that this policy should apply to this application in order to avoid unnecessary delay to Applicants and duplicative examination by the Office.

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Applicants submit that it would not be an undue burden on the Office to search the art concerning Groups I and II at one time. Group II includes only four dependent claims with a relatively limited number of processes and steps. Thus, searching the art concerning Group II would not add significantly to the Office's burden to search the art concerning Group I.

In any event, according to 37 C.F.R. § 1.141(b) and M.P.E.P. § 821.04, once the Office determines that claims drawn to a product and a process of making it are allowable, claims directed to processes of using the same product may be rejoined. Thus, if the Office maintains this restriction requirement, Applicants respectfully request that the Office rejoin the process of use claims 10-13 once the Office determines that the product claims 1-9 and 14-16 are patentable.

Election of Species Requirement

The Office also required an election of a species under 35 U.S.C. § 121 from each of the following:

- (a) A specific amino acid from those listed in claim 1.
- (b) A specific saccharide from those listed in claims 3 and 4.
- (c) A specific blood clotting factor or other protein from those listed in claim 2.

Applicants provisionally elect, with traverse, the combination in which arginine is the amino acid, sucrose is the saccharide, and FVIII (Factor VIII) is the blood clotting factor or other protein.

Applicants traverse this requirement on grounds that it should not unduly burden or tax the Office's resources to examine all of the claimed subject matter of this application at one time. In any event, pursuant to 37 C.F.R. § 1.146, should the Office find the elected species allowable, Applicants respectfully request that the Office continue to examine the full scope of the subject matter of the generic claims to the extent necessary to determine its patentability, as is the duty according to 35 U.S.C. § 121. See M.P.E.P. § 803.02.

This response is accompanied by a Petition for a one-month Extension of Time and a check for \$110.00 to cover the required fee. Please charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: June 27, 2002

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